

REMARKS/ARGUMENTS

Claims 15-27 were pending in this application. Claims 1-14 were previously cancelled. In this amendment, no claims are cancelled or added and claim 15 is amended. After entry of this amendment, claims 15-27 will remain pending. Applicant submits that the amendments to claim 15 are supported by the specification as originally filed and therefore introduce no new matter.

In the Office Action, the Examiner rejected claims 15-27 under 35 USC §112, ¶1, asserting that claim 15 recites “server computer” and asserting that Applicant’s disclosure does not provide any support for a server computer to meet the written description requirement.

In the Office Action, the Examiner also rejected claims 15-27 under 35 USC §112, ¶2, asserting indefiniteness of claim 15.

In the Office Action, the Examiner also rejected claims 15-27 under 35 USC §103(a) asserting obviousness over the combination of U.S. Patent Publication No. 2001/0034619 naming Sherman (hereinafter “Sherman”) in view of U.S. Patent Publication No. 2004/0064391 naming Lange (hereinafter “Lange”).

Each of these rejections is addressed herein.

Rejection under §112, ¶1

The Examiner asserted that the Applicant’s disclosure fails to comply with the written description requirement. Applicant submits that, if the written description requirement is properly applied, claim 15 meets that requirement.

The written description requirement comes from 35 USC §112, ¶1, which reads:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As explained at MPEP §2161.01(I):

The function of the written description requirement is to ensure that the inventor had possession of, as of the filing date of the application relied on, the specific subject matter later claimed by him or her; how the specification accomplishes this is not material. In re Herschler, 591 F.2d 693, 700-01, 200 USPQ 711, 717 (CCPA 1979) and further reiterated in In re Kaslow, 707 F.2d 1366, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). See also MPEP § 2163 - § 2163.04.

The requirements are further elaborated at MPEP §2163(II)(A)(3)(b):

...each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." Hyatt v. Boone, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998).

The steps for rejecting a claim for lacking written description are also set out in MPEP §2163(III)(A):

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general

allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

The process for rejecting a claim for lacking written description is also set out in MPEP §2163.02 ("Standard for Determining Compliance with the Written Description Requirement"):

...Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

Given that the Examiner is objecting to the recitation of a server computer in claim 15, therefore, the fundamental factual inquiry is whether specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed, or more particularly, whether those skilled in the art in February 2004 when the present application was filed, would have recognized that Applicant was in possession of an invention using a server computer, i.e., that Applicant knew that a server computer would support "operations of a website comprising at least a web-based interface" at the time of filing and that such knowledge would be reasonably clear to those skilled in the art.

In the specification as originally filed, at page 12, lines 8-13, for example, it clearly states that "an Internet website 30 acts as a central clearing house for purchase and sale of in-force life insurance policies." A person skilled in the art to which this application pertains, in 2004, would have been aware of the Internet, that a website would be accessible over the Internet and that the website would have been hosted on a server computer. In the specification as originally filed, at page 5, lines 2-4, that "[t]he invention addresses this need by providing an efficient marketplace, in the form of an online auction, for life settlement and viatical transactions." A person skilled in the art would have understood not only that the website would have been hosted on a web server (at least in part), but that person skilled in the art would have understood from reading the specification that the Applicant was aware that implementations of the inventions would use a server to serve pages of the website.

Further examples can be found in the specification as originally filed, at page 6, lines 2-3 ("As a corollary function of the internet website containing the database, ..."), at page 6, lines 13-25 ("The auction is held on a website, where policy owners, either directly or through agents or other authorized parties, give the website access to data relating to an in-force policy to be sold and an auction is held online for each policy that is put up for sale. The seller or agent specifies the conditions, such as with or without reserve, reserve meaning that the policy is withheld from sale if a certain minimum bid is not obtained. The duration of the auction may be set by the website or, if permitted by the website, by the seller or agent (several days or two weeks might be typical). Normally the highest bid thus far will always be displayed ("current bid") so that potential buyers will submit only bids that are higher than the previous high bid."), and elsewhere in the text and figures.

In view of the above, Applicant submits that the Examiner has failed to present evidence to suggest that a person skilled in the art to which the application pertains would have perceived that all the teachings of the application could be performed without a server computer and would have also clearly realized that the Applicant was in possession of that knowledge as well. Therefore, the rejection for lack of written description is improper and Applicant respectfully requests reconsideration.

Rejection under §112, ¶2

While Applicant disagrees that the claim 15 is indefinite in that it would cover systems where original policy owners would input in-force policies without necessarily agreeing at that time to be willing to entertain offers, in order to expedite prosecution, Applicant has amended claim 15 to recite that the original policy owners are willing to entertain offers. It should be understood, however, that nothing in claim 15 prevents it from reading on a system where both occur (i.e., that there exist some records for original policy owners who are willing to entertain offers and some records for original policy owners who may become willing to entertain offers).

Rejection under §103(a)

Claim 15 is allowable over Sherman and Lange as those references, taken alone or in combination, fail to disclose or suggest each element of claim 15, at least as amended. For example, amended claim 15 recites “coordinating auctions between potential buyers of policies and the original policy owners of those policies or their representatives” and that is not disclosed or suggested in any of the cited references. Sherman is directed to teaching how to provide additional insurance, which is the sale of an insurance policy other than a policy of an original policy owner. As explained in detail in the specification, there are many benefits of providing an auction website to bring together original policy owner and potential buyers of their policies. As such, the sale of new, additional or otherwise, policies is not related.

Lange discloses a system and method for creation of Collateralized Life Settlement Obligations (“CLSOs”). In Lange, individual policies are not sold to buyers, but are aggregated so that the group of policies can be collateralized. Thus, Lange also lacks the claimed elements. Furthermore, even though Lange may suggest that original policies are bought and therefore might be sold, nothing suggests “coordinating auctions between potential buyers of policies and the original policy owners of those policies or their representatives”. From Lange, it is apparent that the benefits of at least the claimed auctions between potential buyers of policies and the original policy owners of those policies or their representatives are lost in the system of Lange.

Additional elements are lacking from Sherman and Lange, but the above is sufficient reason for claim 15 to be allowed over the cited references and the rejection of claim 15 under §103(a) is respectfully requested.

Claims 16-27, which depend on claim 15, are also allowable for at least the reasons stated above and for the additional elements that they recite.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

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Respectfully submitted,



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